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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/089,989	04/02/2002	Reiner Fischer	Mo7057/LeA34,002	3254

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EXAMINER

LEVY, NEIL S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 01/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/089,989

Applicant(s)

FISCHER

Examiner

Neil Levy

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/27/03
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-8 is/are pending in the application.
- 4a) Of the above claim(s) 1, 2 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3, 7, 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-4, 6-8 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3/27/03
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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Applicant's election with traverse of Group II, Imidacloprid species in Paper No. 6 is acknowledged. The traversal is on the ground(s) that the EPA did not find lack of unity. This is not found persuasive because for reasons of record, the compounds identified as formula (1) involve multiple base moieties of O, S, O and **5** heterocycles of 3-8 members alone, each independent and distinct, and, as shown for example, by Fisher et al 5994274, not novel, formula 1a can not be a direct representation of (i); there is no Z in 1a.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1, 2 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 10/27/03.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 6 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not

described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification and declaration provide for only limited formula (1).

Compounds, in combination with limited nicotinic agonist, or antagonist, compounds, effective when applied directly to a very limited number of pest species and life stages there of, and to the habitats thereof, and even less showing synergistic, unexpected, efficacy. The number of potential species of pests (there are over 740,000 separate species of insects alone) types of habitats and number of agonists and antagonist compounds would require an astronomical degree experimentation and testing for one in the art to be required to perform, to determine a synergistic combination for a given insect, arachnid, or nematode species.

Imidacloprid and Thiacloprid with 1a are shown effective for aphid and Myzus control on crops

The factors to be considered in determining whether a disclosure meets the enablement requirement of 35 U.S.C. 112, first paragraph, have been described In In re Wands, 8 USPQ2d 1400 (Fed. Cir. 1988). Among these factor are: (1) the nature of the invention; (2) the state of the prior art; (3) the relative skill of those In the art; (4) the predictability or unpredictability of the art; (5) the breadth of the claims; (6) the amount of direction or guidance presented; (7) the presence or absence of working examples; and (8) the quantity of experimentation necessary. When the above factors are weighed, it is the examiner's position that instant disclosure fails to meet the enablement requirement for the following reasons:

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(1) The nature of the invention: claims are to qualified "control: by a specific agent with out specifying the required dosage and incorporation procedures and target species or the required synergistic compound and amounts.

(2) The states of the prior art prior art did not show the use of these compounds for non-specific protection –experimentation was required.

(3) The relative skill of those in the art

The relative skill of those in the art is high

(4) The predictability or unpredictability of the art

The unpredictability of the art is very high. Applicants own specification suggests only limited efficacy

(5) The breadth of the claims

The claims are very broad.

(6) The amount of direction or guidance presented.

(7) The presence or absence of working examples

There are none

(8) the quantity of experimentation necessary extensive – there is no known levels of amount useful for any specific organism control

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 34, ⁷68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al WO 98/42191 and Erdezen et al DE 195 19007, in view of Fischer et al 5262383.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34, ⁷68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hunter et al WO 98/42191 and Erdezen et al DE 19519007, in view of Fisher et al 5262383.

Hunter teaches pest control is improved if combination control agents are used with imid~~ad~~ep~~ri~~d (p. 3, 4, 7) applied directly to the pest or habitat thereof; in this case, the host animal. Erdezen also teaches synergistic effects of imidadopred, here with a variety of structurally and functionally different additional pesticides (p. 2). Examples show the combination compounds at the instant ratios (Table B), effective against the same pests as of the instant invention and Hunter (p.5). Neither reference applies the instant compound (1) or (1a). Fischer does, the instant 1a homolog: (Table 2) when A is cyclohexyl, X, Y is cl, R¹ is C(CH₃)₂ - C₂H₅ and D is O. These and similar compounds are taught as control agents for pests, inclusive of those of Hunter, Erdelen and the instant disclosure (col. 28, bottom). Also suggested is combination with other pesticides (col. 131, lines 24-50) at the instant Ratios.

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Thus, the artisan would find it obvious to prepare particular ingredient combinations, sizes, concentration and ratios of ingredients, depending upon the target species, desired number of applications, length of time for desired protection, ease of handling, concern for amount of active in the environment, and degradation. The amounts and proportions of each ingredient are result effective parameters chosen to obtain the desired effects. It would be obvious to vary the amount of each ingredient to optimize the effect desired (increased pesticide concentration, increased freeze protection etc.

There are no non-obvious and/or unexpected results obtained since the prior art is well aware of the use of the instant compound for pesticidal treatment, and the use of additives synergists, for the functionality for which they are known to be used is not a basis for patentability.

It has not clearly been established by objective showing of some additional unusual and/or unexpected results that the administration of the particular form of active, carrier, synergist or the habitat, pest or particular form of structure to be treated, provides any greater level of prior art expectation as claimed. Further, applicant has showed no criticality as to the synergist or agent.

It would have been obvious a person of ordinary skill in the art at the time the invention was made desiring to utilize pesticides in combination to use those of Hunter/Erden, modified as shown by Fischer in order to provide wide pesticidal efficacy. One would be motivated to use the combination, because the synergistic effects as

taught by primary references permit use of less of the expensive compounds, while reducing chance of development of resistant pests.

Claims 1-3, 6, 7 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7, 10-12, 13-15 of copending Application No. 10/123,332. Although the conflicting claims are not identical, they are not patentably distinct from each other because the application provides similar claims, but not identically worded, thus, obvious variants of each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy whose telephone number is (703) 308-2412. The examiner can normally be reached on Tuesday through Friday 7 AM to 5:30 Pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

Levy/LR
December 30, 2003



NEIL S. LEVY
PRIMARY EXAMINER